UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 7

DR MELVIN BLECHER
4329 VAN NESS ST NW
SECOND FLOOR
WASHINGTON DC 20016-5625

In re Application of :
Stephan, et al. :
Application No. 09/940,454 : ON PETITION
Filed: August 29, 2001 :
Attorney Docket No. 64688/153 :

This is a decision on the Petition for Revival of an Application Abandoned Unavoidably Under 37 CFR 1.137(a), filed November 10, 2003.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The above-identified application became abandoned for failure to timely file a response to the Notice to File Corrected Application Papers, mailed October 9, 2001.[1] This Notice gave applicants an extendable period of reply of two months to file substitute drawings in compliance with 37 CFR 1.84. No extensions of time were obtained. No substitute drawings having been received, the above-identified application became abandoned on December 10, 2001. A Notice of Abandonment was mailed on November 5, 2003.

Consideration of petition under 1.137(a) (Unavoidable Delay)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the

[1] In his petition, petitioner points out that the Notice was allegedly sent via facsimile transmission, and not mailed. Apparently petitioner was advised of this in an oral conversation with an Office employee. While it is true that courtesy copies are sometimes sent via facsimile upon an applicant's request, the Office does not *sua sponte* engage in the practice of faxing original Office correspondence. There is no written record in the application file that the Notice was ever transmitted via facsimile. Petitioner is directed to 37 CFR 1.2.

satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."[2]

Petitioner contends that he did not receive the Notice to File Corrected Application Papers. To establish nonreceipt of an Office action, a practitioner must: (1) include a statement that the Office communication was not received; (2) attest to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and (3) attach a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.[3] Here, petitioner has not included a copy of a satisfactory docket record.

A docket record consists of a "docket report showing **all** replies docketed...."[4] For example, as the Notice to File Corrected Application Papers set a two month period for reply, a petitioner must submit a copy of a docket report showing all replies docketed for a date two months from the mail date of the Notice.[5] Here, petitioner has only included a one page summary of the prosecution history in the above-identified application.

Other matters

Also in his petition, petitioner requests that the application be treated as special, and that 104 weeks be added to the patent term. Petitioner is directed to 37 CFR 1.4(c), which states that "[s]ince different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." Furthermore, petitioner is reminded that petitions to make special must be accompanied by the fee set forth in 37 CFR 1.17(h).

---

[2] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[3] See MPEP 711.03(c)(II).

[4] Id (emphasis added).

[5] See id.

With respect to petitioner's request that 104 weeks be added to the patent term, an application for patent term adjustment must be made pursuant to 37 CFR 1.705, and must be accompanied by the fee set forth in 37 CFR 1.18(e). An application for patent term adjustment can only be filed after mailing of the Notice of Allowance and prior to payment of the Issue Fee.

If petitioner can not establish that the entire period of delay was unavoidable, petitioner may revive the above-identified application under the provisions of 37 CFR 1.137(b), unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

Receipt of the substitute drawings submitted with the petition is acknowledged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (703) 308-6916
Office of Petitions
Attn: Cliff Congo

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, Virginia

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.

Cliff by

Cliff Congo
Petitions Attorney
Office of Petitions